

REMARKS

Applicants note that the Examiner has made the restriction requirement final and have indicated the status of claim 12 above as “Withdrawn.” However, given the necessity for searching methods as well as products in view of the product-by-process structure of the elected claims, applicants respectfully submit that claim 12 should be rejoined and allowed upon the allowance of the remaining claims in this application.

Applicants have amended the claims to recite in greater specificity the process steps used to create the claimed films as disclosed in the examples of this application. The recited process steps contribute to the film properties recited in the independent claims.

The Examiner objected to claims 1, 5 and 7 as using the word “obtainable” instead of “obtained.” Applicants have amended claims 1, 5 and 7 as proposed by the Examiner to overcome the objection, but applicants respectfully note that the “obtainable” form was used in the claims addressed without criticism by the Court of Appeals for the Federal Circuit in the recent case of *Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282, 90 USPQ2d 1769 (Fed. Cir. 2009) (en banc). The objection to claims 1, 5 and 7 should be withdrawn.

Claims 5 and 18 stand rejected as anticipated by Dalman, the Examiner taking the view that Dalman inherently discloses the claimed film. This rejection is respectfully traversed.

The Examiner’s position relies on the belief that since Dalman discloses reacting an aromatic diamine having a benzoxazole structure (5-amino-2-(p-aminophenyl)benzoxazole) with an aromatic tetracarboxylic acid anhydride (pyromellitic dianhydride), it is reasonable to assume that Dalman’s adduct inherently possesses the water residue properties set forth in claims 5 and 18. The difficulty with the Examiner’s reasoning is that the process disclosed in Dalman does not demonstrate any recognition that the amount of water residue is to be controlled or provide any means for doing so. By contrast, the process steps recited in claim 5 as amended do result in films having the claimed properties; as a result, the differences between the process claimed in claim 5 and the processes disclosed in Dalman are such that it is not reasonable for the Examiner

to try to shift the burden of proof to applicants to overcome an alleged case of inherency. Dalman does not disclose or suggest the film product having the water residue properties of claims 5 and 18, so this rejection should be withdrawn.

Claims 5 and 18 stand rejected as anticipated by Harris for the same reasons as articulated with respect to Dalman. The rejections should be withdrawn for the same reasons stated as to Dalman. It is not reasonable to conclude that Harris inherently discloses the water residue properties set forth in claims 5 and 18.

Claims 1-4, 6, 11, 13, 14 and 17 stand rejected under 35 USC 103(a) on Dalman or Harris in view of Asakura. The Examiner takes the position that Asakura discloses the planar orientation coefficient of claim 1 and the motivation to achieve it. This rejection is respectfully traversed.

First, the Examiner's reasoning fails to address the dielectric constant range set forth in claim 1 (which is different from the dielectric loss tangent set forth in claim 2). Dalman discloses a dielectric constant range of between about 2 and 3.3 from about 1 MHz to 1 GHz, while claim 1 specifies a dielectric constant range of 2.-3.1 at **100** GHz, far above what Dalman discloses. Harris does not disclose a dielectric constant at all. Therefore, the Examiner has not provided a reasoned basis why it would have been obvious to arrive at the dielectric constant range of claim 1. As the Examiner knows, it is improper to rely on inherency to support an obviousness rejection unless the alleged inherent subject matter would have been recognized by persons of ordinary skill in the art as existing in the prior art at the time the invention was made. MPEP 2141.02.V. ("Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established.")

Second, the Examiner is assuming without supporting reasoning that the planar orientation coefficient values reported in Asakura would be the same as for the claimed films. The Examiner has to admit that Asakura's films are not the same as those claimed in this application. It is therefore inaccurate for the Examiner to argue that Asakura's disclosed range

of planar orientation coefficients overlaps the claimed range because the Examiner is comparing apples with oranges. The Examiner has provided no evidence that persons of ordinary skill in the art would have arrived at the planar orientation coefficient values for applicants' claimed films based on Asakura's disclosure of different films without the use of prohibited hindsight. Indeed, the rejections relying on Asakura do rely on hindsight because there is nothing in Dalman or Harris that would have given persons of ordinary skill in the art any reason to look to Asakura's disclosure of different films unless they knew of applicants' invention in the first place.

Third, as to claims 2-4, 6, 13 and 14, the Examiner is relying on inherent disclosure in Dalman and Harris to complete cases of obviousness. As explained in MPEP 2141.02.V., this reliance is improper.

Accordingly, the rejections of claims 1-4, 6, 11, 13, 14 and 17 stand rejected under 35 USC 103(a) on Dalman or Harris in view of Asakura should be withdrawn.

Claims 7-9, 15, 16 and 19 stand rejected under 35 USC 103(a) on Harris alone. This rejection is respectfully traversed.

The Examiner admits that Harris does not identically disclose the inventions of the rejected claims but contends that the subject matter of the rejected claims would have been obvious because Harris discloses controlling the solvent residue level of the polyimide precursor to 10-35%, which allegedly overlaps the 25% level taught in the specification. The problem with the Examiner's reasoning is that it assumes what it must establish, on two levels. The first level is that it assumes that controlling the solvent residue level in Harris's process will produce the claimed difference in surface planar orientation properties. The second level is that the Examiner is relying on an alleged inherency as to which there is not evidence it was recognized as an inherent property by persons of ordinary skill in the art at the time applicants' invention was made. In the end, though, the Examiner's reasoning once again does not explain why persons of ordinary skill in the art would have had a reason, based on what they knew at the time

of applicants' invention, to modify Harris to arrive at the claimed invention. Alleged inherent disclosure is not enough to support this rejection.


Early action allowing claims 1-9 and 11-19 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952**, referencing docket no. 358362011300.

Respectfully submitted,

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